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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,317	07/09/2003	Thomas M. Sauter	KTWO121444	2817

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EXAMINER

KLEBE, GERALD B

ART UNIT PAPER NUMBER

3618

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,317

Applicant(s)

SAUTER ET AL.

Examiner

Gerald B. Klebe

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
11 July 2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/09/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment

1. The supplemental power of attorney filed 4/05/2004 appointing Ryan E. Dodge, Jr., Reg. No. 42,492 as an additional attorney in the case is acknowledged. A duplicate of the same, filed 4/26/2004 is further acknowledged as being of record.

Election / Restriction Response

2. Applicant's election filed 5/03/2004 of Species Group C, Figures 15-17, all pending claims 15-27 deemed reading thereon, is acknowledged.

Because Applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Consequently, the restriction is held to be proper, and is hereby made final. An examination on the merits of claims 15-27 follows.

Abstract - Objection

3. The Abstract filed 7/09/2003 is objected to for the following informalities:

The numeric designators found in the abstract should be enclosed within parentheses or the numeric designators should be deleted.

A replacement Abstract, provided on a separate sheet, and correcting the informalities is required.

Claim Objections

4. The claims are objected-to for the following informalities:

In claim 26, line 1 the word "improved" is superfluous and should be deleted.

Claims Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 16 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites that: "the ankle support cuff is completely separate from the upper portion". It seems to the examiner that, clearly, the ankle support cuff being at least partially enclosed by the upper portion would ordinarily be in contact with the upper portion and therefore not completely separate from the upper portion.

Appropriate correction or clarification is required.

For the purposes of further examination on the merits the interpretation will be that the cuff and the upper portion are not mechanically connected together.

In claim 26, at line 1, the phrase "of the type" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "of the type"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Appropriate correction is required.

Claims Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 15-16, 22-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant.

a. Gierveld discloses an in-line skate comprising: (**re: claims 15 and 25**)

a plurality of wheels;

a base defining an upper and lower surface, toe and heel ends, and a longitudinal axis generally from the toe end to the heel end;

a frame secured to the lower surface of the base mounting wheels;

a non-rigid upper portion secured to the base and adapted to receive a skater's foot; and

(**re: claim 16**) wherein the ankle cuff is completely separate from the upper portion

(since there is no mechanical connection of the cuff to the upper);

(**re: the further limitation of claim 25**) wherein the upper portion extending upwardly

from the base is adapted to terminate below the ankle of the received skater's foot

(Gierveld in Fig 4 shows a low-cut shoe upper); and

(**re: claim 23**) wherein the base is substantially rigid (Fig 4, item 17; refer col 4, lines 34-

35, col 5, lines 53-55).

b. Gierveld lacks explicit disclosure of **the further limitations of claims 15 and 25** of an internal heel counter disposed, mounted within, and covered by the upper portion, and

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projecting upwardly from the heel end of the base, and having an ankle support cuff extending upwardly from the upper portion and pivotally secured to the heel counter, wherein the cuff is pivotable independently of the upper portion, and wherein the pivot is constrained to pivot about an axis transverse to the longitudinal axis defined by the base.

c. However, Swearington teaches a substantially rigid internal heel counter and a substantially rigid ankle support cuff for use within a sport shoe, which heel counter projects upwardly from the heel end of the shoe and is disposed, mounted within, and covered by the upper portion, wherein the ankle support cuff is pivotally secured to the internal heel counter at only lateral and medial sides thereof, and is pivotable independently of the upper portion and wherein the pivot is constrained to pivot about an axis transverse to the longitudinal axis (Fig 1, item 14; refer col 1, line 66 to col 2, line 4 and col 3, lines 5-8) defined by the base of the upper portion.

d. Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant application was made to have modified the skate of Gierveld to include a heel counter and pivotally connected ankle support cuff disposed, mounted within, covered by the skate upper portion, the heel counter projecting upwardly from the heel end of the upper and the cuff not being mechanically fixed to the upper portion so that it is pivotable independently of the upper portion.

e. Regarding the further limitations of claims 15 and 25:

- wherein the heel counter is fixedly secured to the base. The combination of Gierveld and Swearington lacks explicit disclosure that the counter is fixed to the base. However, it is old and known in the art to secure elements within athletic footwear in order to have them

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immediately available in-place as they are to be used when wearing the shoe. Therefore it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have fixedly secured the internal heel counter and pivotable ankle support cuff apparatus of Swearington in the upper portion of the skate of Gierveld in order to ensure that the device was available and ready in-place in the shoe whenever the skate is to be used; and,

-wherein the ankle support cuff includes a pad which lines an interior of the cuff. It is old and well-known to provide pads for portions of wearable sports gear, including footwear.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to provide padding on the interior of the ankle support cuff in order to help prevent chafing of the skater's ankle and leg during skating; and,

-wherein the ankle support cuff is external to the upper portion. It is clear from the observation that the upper portion of Gierveld is a low-cut shoe, and therefore that, at least an upper part of the ankle support cuff taught by Swearington would extend outwardly above the top of the upper portion of the skate of the combination of Gierveld and Swearington as discussed above.

f. **Regarding the limitations of claim 22** of having a gap defined between a lower rear edge of the cuff and an upper rear edge of the upper portion, it would have been an obvious design choice to have provided for a clearance between the lower rear edge of the cuff and the upper rear edge of the upper of the shoe in order to provide clearance enabling the cuff to pivot without interference by abutting the upper edge(s) of the shoe upper.

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9. Claims 17-18, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant, and further in view of Olson et al. (US 5171033).

As discussed above, the combination of Gierveld and Swearington discloses all of the features of claim 15 from which claims 17-18 depend. The combination of Gierveld and Swearington lacks explicit disclosure wherein (**re: claim 17**) the ankle pad extends downwardly between the ankle support cuff and within the internal heel counter, and (**re: claim 18**) wherein a lower edge of the ankle pad is free and separate from the internal heel counter.

However, Olson et al. teaches a skate with an ankle cuff (Fig 2, item 30) and employing a pad (26) which lines an interior surface of the ankle cuff and extends downwardly into and is received within an interior of the heel counter (50; refer Fig 2 and associated text, including col 6, lines 37-39, and col 5, lines) and further, wherein the lower edge of the ankle pad is free and separate from the internal heel counter (refer item 26, Figs 1, 2 and col 5, lines 25-28).

Therefore it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skate of the combination of Gierveld and Swearington to include a pad lining the interior of the ankle cuff and heel counter and separate from the heel counter in accordance with the teachings of Olson et al. in order alleviate chafing of the skater's ankle and leg during skating, as suggested by the reference at column 5, lines 28-31.

10. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant, and further in view of Thorson (US 5443267).

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As discussed above, the combination of Gierveld and Swearington discloses all of the features of claim 15 from which claims 19-21 depend.

The combination of Gierveld and Swearington is silent regarding the skate further comprising (**re: claim 19**) at least a partial outer ankle shell that is non-rigid (**re: claim 20**) covering an exterior of the cuff, wherein (**re: claim 21**) at least a portion of the cuff is exposed between the outer ankle shell and the upper portion of the shoe.

However, Thorson teaches an ankle support cuff (16) pivotably connected to a heel counter (22; refer also to Figs 5, 6) for use within a shoe further comprising a non-rigid partial outer ankle shell (30) covering an exterior of the cuff wherein a portion of the ankle support cuff is exposed between the outer ankle shell and the upper of the shoe.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skate of the combination of Gierveld and Swearington to include a non-rigid partial outer ankle shell covering an exterior of the cuff and wherein a portion of the cuff is exposed between the shell and the shoe upper portion in accordance with the teachings of Thorson in order to ensure a firmly secure, but comfortable attachment of the ankle support cuff to the ankle and leg of the skater while the ankle undergoes flexing during skating.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant, and further in view of Olson et al. (US 5171033).

As discussed above, the combination of Gierveld and Swearington teaches a skate having all of the features of claim 15 from which claim 24 depends.

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The combination of Gierveld and Swearington is lacks explicit disclosure that the upper portion comprises a breathable fabric.

However, Olson et al. teaches the use of a breathable fabric in the construction of an in-line skate (refer col 5, lines 35-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of the combination of Gierveld and Swearington to indicate the use of a breathable fabric for the upper portion in accordance with the teachings of Olson et al. in order to provide a wicking effect to absorb and draw foot moisture away from the foot as suggested by the reference at column 5, lines 35-39).

12. Claim 26, as best understood by the examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant.

a. Gierveld discloses an in-line skate including wheels, a base defining an upper and lower surface and a longitudinal axis, a frame secured to the base and mounting the wheels, a non-rigid upper portion extending upwardly from the base and adapted to terminate below the ankle of the received skater's foot.

b. Gierveld lacks explicit disclosure of a substantially rigid internal heel counter partially covered by the upper portion and an external ankle cuff pivotally connected to the internal heel counter, the pivotability being free of resistance from the upper portion.

c. However, Swearington teaches a substantial rigid heel counter adapted to be mounted within and at least partially covered by the upper portion of an athletic shoe, and having an external ankle cuff pivotally connected to the heel counter and pivotable relative to the heel

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counter free of resistance from the upper portion wherein the cuff pivots about an axis that is transverse to the longitudinal axis defined by the base.

d. Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skate of Gierveld to incorporate the internal heel counter and pivotable connected thereto external ankle cuff in accordance with the teachings of Swearington in order to provide a comfortable ankle support stabilizing the ankle from rotations except about an axis transverse to the longitudinal axis of the upper portion in order to help support the ankle against injury during skating maneuvers as suggested by the reference at column 1, lines 53-57.

e. Although Gierveld is silent as to the upper portion being non-rigid, Gierveld states that the upper portion is old and known (refer column 2, line 21, wherein is implied the shoe being made of various materials which, clearly, would include non-rigid materials). The non-rigidity of the material of which the upper is constructed further is implied by the use of lacing for closing and securing the shoe over the foot of the skater (see Fig 4).

f. Regarding the limitation that the cuff pivot connection to the internal heel counter permits rotation **only about a transverse axis**, Swearington's design uses two pivot elements to permit (1) rotations of the cuff about a transverse axis (refer Fig 1, item 14) that are normal extent for flexion of the foot, and (2) rotations of limited range about a longitudinal axis (item 18) defined by the shoe upper portion (refer col 1, lines 49-57) .

However, it has been held to be within the skill of a worker in the art to omit an element and omit the feature provided thereby. Therefore, it would have been obvious to omit the element enabling rotation about the longitudinal axis, the resulting device thus permitting the

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pivoting function only about an axis transverse to the longitudinal axis because the function of pivoting about the longitudinal axis is not desired or required. *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989); *In re Larson*, 340 F.2d 965, 144 USPQ 347 (CCPA 1965); and, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

13. Claim 27, as best understood by the examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Gierveld (US 5046746) in view of Swearington (US 5056509), cited by Applicant, and further in view of Olson et al. (US 5171033).

As discussed above, the combination of Gierveld and Swearington discloses all of the features of claim 26 from which claim 27 depends.

The combination of Gierveld and Swearington is silent regarding the use of an ankle pad lining an interior surface of the external ankle cuff and extending downwardly into and received within an interior of the heel counter.

However, Olson et al. teaches a skate with an ankle cuff (Fig 2, item 30) and employing a pad (26) which lines an interior surface of the ankle cuff and extends downwardly into and is received within an interior of the heel counter (50; refer Fig 2 and associated text, including col 6, lines 37-39, and col 5, lines).

Therefore it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skate of the combination of Gierveld and Swearington to include a pad lining the interior of the ankle cuff and heel counter in accordance with the teachings of Olson et al. in order alleviate chafing as suggested by the reference at column 5, lines 28-31.

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Prior Art made of Reference

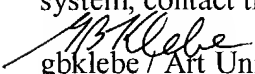
14. The prior art made of reference and not relied upon is considered pertinent to applicant's disclosure. The prior art of Borden teaches a pivotable ankle support and heel counter combination having securing straps to secure the cuff to the leg and ankle; Pozzobon teaches a boot with interconnected pivotable ankle cuff interconnected with the heel counter of the boot. These references also show other structures in common with some of the other features of the apparatus described in the instant application.

Conclusion

15. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-305-0168.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 11 July 2004

 7/12/04
ALLEN SHRIVER
PATENT EXAMINER